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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/042,625

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Francis Ambrose Broderick

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09/12/2006

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EXAMINER

DESHPANDE, KALYAN K

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/042,625	Applicant(s) BRODERICK ET AL.	
	Examiner Kalyan K. Deshpande	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The following is a final office action in response to the communications received on July 3, 2006. Claims 1-8 are now pending in this application.

Response to Amendments

2. Applicants' amendments to claim 1 are acknowledged. Examiner has reconsidered and withdrawn the 35 U.S.C. §112 (1st Paragraph) and 35 U.S.C §101 rejections. Examiner maintains the 35 U.S.C. §103 rejections. Examiner is resubmitting reference Alter (Alter, Steven; *Information Systems: A Management Perspective*, 2nd Edition, The Benjamin/Cummings Publishing Company, 1996) newly citing pages 551-556 and 558.

Response to Arguments

3. Applicants' arguments filed on July 3, 2006 have been fully considered but are not found persuasive. Applicants argues i) Alter fails to teach "determining, according to the project business need, a number of IT sites spread over a geographic area", ii) Alter fails to teach "determining, according to the project technical need, the skilled people groups and computer equipment over said IT sites inside the geographic area", iii) Alter fails to teach "consolidating the IT sites of the geographic area by considering project cost parameters and geographic site locations peculiarities" and iv) there is no expectation of success in modifying Alter, thereby a prime facie case of obviousness has not been established.

In response to Applicants' argument Alter fails to teach "determining, according to the project business need, a number of IT sites spread over a geographic area", Examiner respectfully disagrees. Alter does teach "determining, according to the project business need, a number of IT sites spread over a geographic area" (see pp. 551-559 and 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines. The data centers are determined in accordance to the business needs.). Alter's figure 13.1 specifically depicts the location of computers in the data center are determined based on the business processes required.

In response to Applicants' argument Alter fails to teach "determining, according to the project technical need, the skilled people groups and computer equipment over said IT sites inside the geographic area", Examiner respectfully disagrees. Alter does teach "determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area" (see p. 551-559; where distinct roles are assigned to specific personnel who have the requisite skill set to perform the assigned tasks. The specific personnel are determined based on the technical requirements of the IS plan.). Alter teaches resources are allocated based on the business and technical needs of each project (see p. 556).

In response to Applicants' argument Alter fails to teach "consolidating the IT sites of the geographic area by considering project cost parameters and geographic site locations peculiarities", Examiner respectfully disagrees. Although Alter fails to explicitly

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teach consolidating IT sites based on cost parameters and site peculiarities, Alter does suggest this feature and does teach applying cost-benefit analysis for the project and accounting for commonly overlooked costs regarding hardware and site preparation such as re-wiring a site (see pp. 570-572). Consolidating IT sites based on costs and location peculiarities is part of Alter's teaching of commonly overlooked costs and costs associated with site preparation. Furthermore, Alter teaches the centralization and decentralization of hardware as a compromise between "convenience and accessibility of local data and control and maintainability of centralized data" (see p. 565). The consideration of "convenience and accessibility of local data and control and maintainability of centralized data" is the same as the consideration of "consolidating the IT sites of the geographic area by considering project cost parameters and geographic site locations peculiarities". The advantage of consolidating IT sites based on costs and location peculiarities is that it improves the project and system efficiency. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to modify Alter to account for consolidate IT sites based on cost and location peculiarities based on Alter's teachings of common costs and commonly overlooked costs in order to increase the efficiency of both the project and the system, which is a goal of Alter (see p. 570).

In response to Applicants' argument there is no expectation of success in modifying Alter, thereby a prime facie case of obviousness has not been established, Examiner respectfully disagrees. The prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success.

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In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, Alter can be reasonably modified to include the feature of "consolidating the IT sites of the geographic area by considering project cost parameters and geographic site locations peculiarities" because Alter teaches the implementation of technology while considering a cost/benefit determination. Thus, Examiner has provided a reasonable expectation and has established a prime facie case of obviousness.

Examiner notes the following discussion of Official Notice taken from the MPEP:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. (MPEP § 2144.03(C))

Applicants have not "specifically point[ed] out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." Applicants silence on Examiner's Official Notice of "entering data into a database after it has been collected" and

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“repeating steps in a process” is a lack of a challenge to Examiner’s use of Official Notice. For these reasons, “entering data into a database after it has been collected” and “repeating steps in a process” are taken to be admitted prior art because of Applicant’s silence on these matters.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alter (Alter, Steven; *Information Systems: A Management Perspective*, 2nd Edition, The Benjamin/Cummings Publishing Company, 1996).

As per claim 1, Alter teaches:

A project management method for optimizing Information Technology (IT) sites including skilled people groups and computer equipment, said method comprising the steps of:

defining a project business need (see pp. 558-559; where information systems plans are linked to a company’s business plan. The critical success factors include business needs such as improving customer relationships, improving supplier relationships, making the best use of inventory, and using capital and human resources efficiently and effectively. Furthermore, these business needs are broken down into business processes and can be reengineered.). ;

defining a project technical need (see pp. 552-553; where specific technical needs are determined and defined.);

determining, according to the project business need, a number of IT sites spread over a geographic area (see pp. 551-559 and 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines. The data centers are determined in accordance to the business needs.);

determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area (see p. 551-559; where distinct roles are assigned to specific personnel who have the requisite skill set to perform the assigned tasks. The specific personnel are determined based on the technical requirements of the IS plan.);

grouping and distributing, according to technical constraints, said skilled people groups and computer equipment over said IT sites inside the geographic area (see pp. 557 and 564-65; where skilled personnel are grouped in to general roles. Equipment and personnel are distributed based on technical constraints. The technical constraints include decentralized systems that account for local variances versus centralized systems that perform cross-departmental functions well).

Alter fails to explicitly teach consolidating IT sites based on cost parameters and site peculiarities. Alter does teach, however, applying cost-benefit analysis for the project and accounting for commonly overlooked costs regarding hardware and site

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preparation such as re-wiring a site (see pp. 570-572). Consolidating IT sites based on costs and location peculiarities is part of Alter's teaching of commonly overlooked costs and costs associated with site preparation. The advantage of consolidating IT sites based on costs and location peculiarities is that it improves the project and system efficiency. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to account for consolidate IT sites based on cost and location peculiarities from Alter's teachings of common costs and commonly overlooked costs in order to increase the efficiency of both the project and the system, which is a goal of Alter (see p. 570).

As per claim 2, Alter teaches:

The method of claim 1, further comprising the step of process and method standardization before the consolidating step, said process and method standardization step comprising the steps of:

listing processes and methods used in the IT sites as determined (see pp. 559 and 565-566; where corporate standards and procedures are determined);

listing criteria allowing assessment of efficiency of said processes and methods in the IT sites as determined and according to the skilled people groups and computer equipment as determined, grouped, and distributed (see pp. 570-574; where assessment of efficiency is determined using multiple standards and procedures);

determining best processes and methods according to values of said criteria; and
(see pp. 565-566 and 570-574; where best practices are determined and
implemented and can be based on efficiency),

implementing the best processes and methods in the IT sites as determined (see
pp. 565-566 and 570-574; where best practices are determined and implemented
and can be based on efficiency).

As per claim 3, Alter teaches:

The method of claim 2 wherein the step of determining the best processes and
method further comprises the steps of:

creating with a graphic user interface an evolutionary image of the values of the
criteria (see p. 573; where a graph displaying costs, benefits and cumulative net
benefit is created for a project); and

analyzing the image for determining the best processes and methods (see p.
573; where the image is analyzed to determined the value of the project).

Alter fails to explicitly teach entering the values into a database. It is old and
well-known in the art to enter data into a database after it has been collected so that the
data can be pulled to generate graphs and reports. The advantage of storing the data
in a database is that the data can be easily accessible, thereby increasing the efficiency
of the system. It would have been obvious, at the time of the invention, to one of
ordinary skill in the art to store data in to a database in order to increase the overall
system efficiency, which is a goal of Alter (see p. 570).

As per claims 4 and 5, Alter fails to explicitly teach repeating the steps of listing criteria, determining best processes and methods, and implementing the best processes and practices. It is old and well known in the art to repeat steps in a process. The advantage of repeating steps is that repeating critical steps ensure the accuracy of the result of the steps. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to repeat the steps of listing criteria, determining the best processes and practices, and implementing the best processes and practices in order to ensure the accuracy of the results of the steps, which is a goal of Alter (see p. 570).

As per claim 6, Alter teaches:

The method of claim 1 wherein the IT sites are spread over more than one geographic area (see pp. 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines.).

As per claim 7, Alter teaches:

The method of claim 1, further comprising a step of determining, before the step of determining skilled people groups and computer equipment, a management organization for the geographic area (see p. 557; where project manage roles are assigned. Each IS department or region is accounted for).

As per claim 8, Alter teaches:

The method of claim 1, further comprising after each step, a step of updating a project management tool displaying a time for executing each step of the method of

claim 1 (see p. 576; where a Gantt chart is a tool used to display a time for executing steps of a project).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

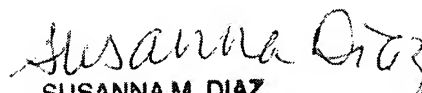
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571)272-5880. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


kkd


SUSANNA M. DIAZ
PRIMARY EXAMINER

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